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Remarks

In the present response, claim 1-36 are presented for examination. Applicants believe that no new matter is entered.

I. Claim Rejections: 35 USC § 101

Claims 1-22 are rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse.

Claims 1-22 are amended to recite a computer system. Applicants respectfully argue that the rejection is cured.

II. Claim Rejections: 35 USC § 103

Claims 1-8, 12-15, 20-26, 30-31, and 35 are rejected under 35 USC § 103 as being unpatentable over USPN 6,085,030 (Whitehead) in view of USPN 6,263,379 (Atkinson). Applicants respectfully traverse.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

All Claim Elements Not Taught or Suggested

Whitehead in view of Atkinson does not teach or suggest all the elements of the independent claims. For example, claim 1 recites "wherein the message from the task includes a binding-type indicator to instruct the resource mediator on resolving the local name." This recitation is not taught or suggested in Whitehead and Atkinson.

First, the Office Action even admits that "Whitehead does not explicitly teach a binding type indicator" (OA of 06/29/05 at p. 4). Applicants agree with this admission. The Office Action, however, attempts to cure this deficiency with Atkinson. Applicants respectfully disagree.

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Nowhere does Atkinson teach or suggest that a message from the task includes a binding-type indicator to instruct the resource mediator on resolving the local name. Atkinson teaches methods and systems for "generating links to source date incorporated within a compound document" (col. 9, lines 3-5). Compound document contains data, text, and images that are generated from different software applications (example Word, Excel, Adobe, etc.). Atkinson attempts to solve the problem that data in prior compound documents could not be easily modified (see col. 2, lines 14-24).

In order to solve the noted problem with compound documents, Atkinson uses "monikers." Monikers are references to a link source (col. 10, line 56). In other words, monikers are paths or links ("A composite moniker is conceptually a path to a source object", see col. 11, lines 10-11; a moniker is a "path name in a file system", see col. 11, lines 63-65; a moniker "contains a pointer to the instantiated source object", see col. 12, lines 6-7). FIGS. 6-8 in Atkinson illustrate how a word processing program uses a moniker. "When the word processing program displays the chart ... it first instantiates a moniker object ... and then requests the moniker to bind to the file indicated by the loaded data" (col. 14, lines 17-23: portions omitted). Nowhere does Atkinson teach or suggest that the message or request itself can include a binding-type indicator to instruct a resource mediator on resolving the local name. Atkinson is completely silent on this issue. In other words, nowhere does Atkinson teach or suggest that monikers provide messages or requests that include a binding-type indicator to instruct a resource mediator on resolving the local name. In Atkinson, there is no resolution to be made. By contrast, the moniker provides a path or link through which a program can bind to the data.

The Office Action cites col. 10, line 52 – col. 11, line 8 for teaching that a message from the task includes a binding-type indicator to instruct the resource mediator on resolving the local name. Applicants respectfully disagree. This section of Atkinson merely discusses that monikers identify the linked data and provide a method through which a program can bind to the linked data. Nowhere does Atkinson teach or suggest that an instruction is made to a resource mediator to resolve the local name. First, a mediator is not required in Atkinson since the moniker provides the link or path. Second, there is nothing to resolve in Atkinson since the moniker provides a method through which a program binds to the linked data.

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For at least these reasons, Applicants respectfully request withdraw of the
rejections. Applicants provide further remarks regarding recitations in the independent
claims.

Claim 1

Claim 1 recites numerous limitations that are not taught or suggested in
Whitehead in view of Atkinson. For example, claim 1 recites "wherein the message from
the task includes a binding-type indicator to instruct the resource mediator on resolving
the local name." As argued, nowhere do Whitehead and Atkinson teach or suggest this
recitation.

For at least these reasons, claim 1 and all its dependent claims are allowable over
Whitehead and Atkinson.

Claim 3

Claim 3 recites numerous limitations that are not taught or suggested in
Whitehead in view of Atkinson. For example, claim 3 recites "wherein the flexible
binding includes a binding-type indicator that informs the resource mediator of whether
to use references to a resource descriptor or the description of the desired resource when
resolving the local name." As noted above, Whitehead and Atkinson do not teach or
suggest this limitation.

As another example, claim 3 recites a resource mediator that identifies a resource
handler task for handling the message by resolving the local name **using an arbitration
policy to select one of the available resources.** Nowhere does Whitehead or Atkinson
teach or suggest such an arbitration policy.

For at least these reasons, claim 3 is allowable over Whitehead and Atkinson.

Claim 6

Claim 6 recites numerous limitations that are not taught or suggested in
Whitehead in view of Atkinson. For example, claim 6 recites "a binding-type indicator
that causes the resource mediator to use a tight binding to resolve the local name if any
references to a resource descriptor correspond to one of available resources and to use the

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flexible binding otherwise such that the flexible binding is based on the description of the desired resource." As noted above, Whitehead and Atkinson do not teach or suggest this limitation.

As another example, claim 6 recites wherein an **arbitration policy is used to select a resource if plural available resources are available**. Nowhere does Whitehead or Atkinson teach or suggest such an arbitration policy.

For at least these reasons, claim 6 and its dependents are allowable over Whitehead and Atkinson.

Claim 22

Claim 22 recites numerous limitations that are not taught or suggested in Whitehead. For example, claim 22 recites "using a binding-type indicator to specify one of flexible binding or tight binding." As noted above, Whitehead and Atkinson do not teach or suggest this limitation.

For at least this reason, claim 22 and its dependents are allowable over Whitehead and Atkinson.

No Suggestion or Motivation to Combine

Applicants argue that no motivation or suggestion exists for combing Whitehead and Atkinson. Whitehead and Atkinson are two different inventions that are directed to solving two different problems. Whitehead is directed to discovering software and hardware components in a distributed computer systems (see col. 4, lines 13-26). Whitehead attempts to solve the problem that prior distributed computer systems were "locked into" hardware, programming languages, etc. (see col. 3, lines 41-56). By contrast, Atkinson is directed to a different invention that solves a completely different problem. Atkinson teaches methods and systems for "generating links to source date incorporated within a compound document" (col. 9, lines 3-5). Compound documents contain data, text, and images that are generated from different software applications (example Word, Excel, Adobe, etc.). Atkinson attempts to solve the problem that data in prior compound documents could not be easily modified (see col. 2, lines 14-24).

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In short, Applicants argue that Whitehead and Atkinson are directed to completely different inventions that attempt to solve completely different problems. No motivation or suggestion exists to combine these references.

Applicants further argue that the law on combination is well established. For instance, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

If the Examiner continues to maintain this rejection, Applicants respectfully ask for objective evidence for the requisite motivation or suggestion to combine and/or modify Whitehead and Atkinson.

For at least these reasons, Applicants respectfully request withdraw of the rejections.

No Reasonable Expectation of Success

Even assuming *arguendo* that Whitehead and Atkinson are combinable (which they are not), no reasonable expectation of success exists. In other words, even if Whitehead and Atkinson are combined, this combination does not teach or suggest the claimed invention.

Whitehead specifically teaches how component requests are directed through the CMS (Component Management Service: see FIG. 2 #280) and the network. With reference to FIG. 2, Whitehead teaches: "If the component is available, binding

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information is returned to the requesting consumer application 210 via paths 22 or 23. If the component is not available, the request is forwarded to the object factory 240 via path 11 to activate an object corresponding to the requested component." (See Col. 8, lines 6-14). Nowhere does Whitehead teach or suggest that the message or request itself can include a binding-type indicator to instruct the CMS on resolving the local name.

Atkinson teaches that compound documents can incorporate linked data called a "moniker." (see col. 10, lines 52-59). FIGS. 6-8 illustrate how a word processing program uses a moniker. "When the word processing program displays the chart ... it first instantiates a moniker object ... and then requests the moniker to bind to the file indicated by the loaded data" (col. 14, lines 17-23: portions omitted). Nowhere does Atkinson teach or suggest that the message or request itself can include a binding-type indicator to instruct a resource mediator on resolving the local name.

In short, Applicants argue that even if Whitehead and Atkinson are combined, this combination will not produce a reasonable expectation of success for teaching the recitations of the claims. Specifically, no reasonable expectation of success exists for teaching or suggesting the recitation that a message or request itself can include a binding-type indicator to instruct a resource mediator on resolving the local name.

For at least these reasons, Applicants respectfully request withdraw of the rejections.

IV. Claim Rejections: 35 USC § 103

Claims 9 and 27 are rejected under 35 USC § 103 as being unpatentable over Whitehead in view of Atkinson and USPN 5,790,853 (Nomura). Applicants respectfully traverse.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

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As noted in connection with claims 1 and 22, Whitehead and Atkinson do not teach or suggest all of the claimed elements in claims 1 and 22. Nomura fails to cure the deficiencies of Whitehead and Atkinson. Thus, for at least the reasons given in connection with claims 1 and 22, respective dependent claims 9 and 27 are allowable over Whitehead in view of Atkinson and Nomura.

V. Claim Rejections: 35 USC § 103

Claims 10-11, 16-19, 28-29, and 32-34 are rejected under 35 USC § 103 as being unpatentable over Whitehead in view of Atkinson and USPN 5,632,600 (Ji). Applicants respectfully traverse.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

As noted in connection with claims 1 and 22, Whitehead and Atkinson do not teach or suggest all of the claimed elements in claims 1 and 22. Ji fails to cure the deficiencies of Whitehead and Atkinson. Thus, for at least the reasons given in connection with claims 1 and 22, respective dependent claims 10-11, 16-19, 28-29, and 32-34 are allowable over Whitehead in view of Atkinson and Ji.

VI. New Claim

New claim 36 recites using an arbitration policy to select a resource if more than one resource matches the description of the desired resource. Applicants respectfully submit that the art of record does not teach or suggest this recitation.

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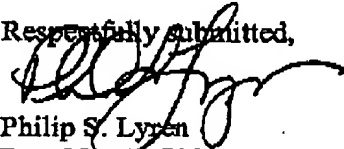Serial No.: 09/186,450
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CONCLUSION

In view of the above, Applicants believe all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Philip S. Lyren
Reg. No. 40,709
Ph: 281-514-8236

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